

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

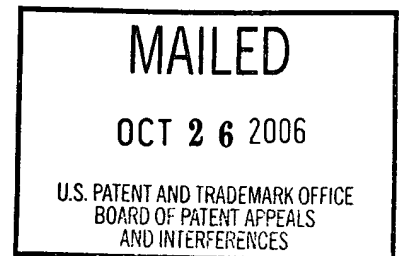
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MICHAEL L. BEIGEL, NATHANIEL POLISH,
STEVEN R. FRANK and ROBERT E. MALM

Appeal No. 2005-0171
Application No. 10/064,380

ON BRIEF



Before JERRY SMITH, BARRETT, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request that we reconsider that portion of our decision of June 27, 2005 wherein we sustained the Examiner's 35 U.S.C. § 102(e) rejection of claims 36 and 39 based on the Buchele reference, the 35 U.S.C. § 102(e) rejection of claims 70, 71, and 75 based on the Carroll reference, and the 35 U.S.C. § 103(a) rejection of claims 47 and 56-60 based on the Carroll reference.

Appeal No. 2005-0171
Application No. 10/064,380

Initially, with respect to claim 36, we find ourselves in agreement with Appellants that the Examiner has not properly interpreted the "means for coupling the capacitor(s) to the coil" limitation of the claim in accordance with the decision in In re Donaldson, 16 F.3d 1189, 1191, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994). As alluded to by Appellants, in order to properly interpret a claimed means-plus-function element, the Examiner's burden of establishing a prima facie case involves at least two requirements. Initially, the Examiner must provide evidence that the structure identified in a prior art reference actually performs the function set forth in the claims. Further, the Examiner is required to show whether the identified prior art structure which performs such a function is equivalent to the structure disclosed in Appellants' specification.

On reconsideration of the Examiner's stated position in light of Appellants' arguments in the Request, it is apparent that the Examiner's analysis satisfies neither of the above requirements. As argued by Appellants, the capacitor coupling means of claim 36 must be interpreted as corresponding to the

structure disclosed in Appellants' specification, i.e., a structure, as illustrated in Appellants' Figure 2, in which one capacitor terminal connects to a coil terminal and the other capacitor terminal connects to a driver terminal. We agree with Appellants that the Examiner has failed to provide any evidence, other than the mere opinion, that the structure disclosed by the Buchele reference is an equivalent to the claimed coupling means.

As asserted by Appellants, the capacitor 160 in Buchele, which is merely connected across the DC power source 170 for the driver 110, cannot be reasonably interpreted as providing a coupling of the capacitor 160 to coil 190. Further, It is further our opinion that, even assuming arguendo that the capacitor connecting structure of Buchele could be interpreted as performing the claimed coupling function set forth in means-plus-function format, the Examiner has failed to meet the burden of showing how such structure is equivalent to Appellants' disclosed structure in the specification. In this regard, the disclosure of the Buchele reference simply does not provide the factual basis necessary to support a finding that the capacitor and its

Appeal No. 2005-0171
Application No. 10/064,380

associated connecting circuit structure disclosed therein are of the equivalent structure and arranged in an equivalent manner to that described in Appellants' disclosure. Accordingly, the Examiner's 35 U.S.C. § 102(e) rejection of claim 36, as well as claim 39 dependent thereon, based on the Buchele reference, is reversed.

We would point out that, although our reversal of the Examiner's rejection of claims 36 and 39 is based on a lack of evidence on the record before us, this is not to be taken as an indication that no evidence exists to support the Examiner's position. Further, although we have found that Buchele does not disclose an equivalent structure under 35 U.S.C. § 102, MPEP § 2183 also notes that the Examiner should consider whether the prior art supports a rejection under 35 U.S.C. § 103. We have made no findings as to whether the claimed coupling means would have been obvious to the artisan within the meaning of 35 U.S.C. § 103. We leave it to the Examiner to determine in the first instance whether a rejection under 35 U.S.C. § 103 is appropriate based on Buchele or any other prior art.

Appeal No. 2005-0171
Application No. 10/064,380

With respect to the 35 U.S.C. § 102(e) rejection of claims 70, 71, and 75 based on the Carroll reference, and the 35 U.S.C. § 103(a) rejection of claim 47 and 57 based on the Carroll reference, we have reconsidered our original decision in light of Appellants' comments in the Request for Rehearing, and we find no error therein. We, therefore, decline to make any changes in our prior decision which affirms these rejections for the reasons which follow.

Regarding claim 70, Appellants contend (Request, pages 4-6) that our earlier decision erred in concluding that Carroll's generated alternating magnetic field has a bit-timing clock signal embedded therein. According to Appellants, the output of Carroll's element 58 does not contain a bit-timing clock signal and, further, there is no bit-timing clock signal generated in the controller 10. We do not find this persuasive. We find no error in the Examiner's line of reasoning that concluded that the output of Carroll's element 58 which provides a clock signal input to timing control 60 has embedded therein a bit-timing clock signal as claimed. It is noteworthy that Appellants admit (id., at 5) that the output of Carroll's divide-by-64 timing control element 60 is a bit-timing control signal.

It is this control signal that Carroll's transponder 40 transmits to controller 10, which extracts this bit-timing data and utilizes it to develop a bit-timing signal which is embedded in the data transmitted (Carroll, Figure 4B) from the controller 10 to the transponder 40. As we stated in our earlier decision, there is no claimed requirement that the bit-timing control signal originate in Carroll's controller as argued by Appellants.

With respect to claim 71, we also find no error in our original decision which concluded that language in the claim preamble which recites that a bit-timing clock signal originates with the interrogator be given no patentable weight since there is no clear indication that the generation of a bit-timing clock signal in the body of the claim refers back to the claim preamble. We don't necessarily disagree with Appellants' argument (Request, pages 8 and 9) that there must be an initial establishment of interrogator-tag communication which originates in the interrogator. It is apparent, however, from our reading of Carroll that, in the ongoing communication between the controller (interrogator) and the transponder (tag), the

controller is responding to bit-timing control signals generated at the transponder by utilizing such signal information and embedding it in the signals transmitted back to the transponder (Carroll, Figure 4B).

Similarly, we find no error in our original decision affirming the Examiner's 35 U.S.C. § 102(e) rejection of claim 75 based on Carroll. Again we refer to the illustration in Carroll's Figure 4B along with the accompanying disclosure at column 16, lines 1-10 which describes the transmission of a command word 112 from the controller 10 to transponder 40 which incorporates, i.e., embeds, a synchronization block 114. Further, as described at column 16, lines 46-52 of Carroll, the sending of the command word 112 from the controller to the transponder is synchronized with the bit timing of the configuration word 100 from the transponder.

We are also unpersuaded by Appellants' argument asserting that our original decision misinterpreted Judge Rader's concurring opinion in the Seal-Flex case as it relates to an In re Donaldson analysis of method claims. We find no error in our finding that the method steps set forth in method claims 70, 71, and 75 recite "acts" and not "functions" which would invoke the

Appeal No. 2005-0171
Application No. 10/064,380

sixth paragraph of 35 U.S.C. § 112 requiring that such claim limitations be interpreted as step-plus-function limitations. We find no basis for Appellants' assertion that the method steps of claims 70, 71, 75 are analogous to the step of "adhering the mat to the foundation" which Judge Rader's opinion in the Seal-Flex case suggested would set forth a function which would be governed by the sixth paragraph of 35 U.S.C. § 112. We remain of the opinion that the method steps of, for example, "embedding a bit timing clock signal" (claim 70) and "generating a bit-timing clock signal" (claims 71 and 75) do not recite "functions" but rather recite "acts" which describe how the underlying function of tag interrogation is performed.

We also find to be without merit Appellants' assertion of error in our original decision affirming the Examiner's 35 U.S.C. § 103(a) rejection of claims 47 and 56 based on Carroll. Appellants have not attacked our agreement with the Examiner's line of reasoning asserting the obviousness to the skilled artisan of including a tuning capacitor in the circuitry of Carroll. Rather, Appellants' arguments in the Request reiterate those made with respect to claims 70, 71, and 75 which contend

Appeal No. 2005-0171
Application No. 10/064,380

that there is no bit-timing clock signal embedded in the signal received from the controller by the transponder in Carroll, arguments we found to be unpersuasive for all of the reasons discussed supra.

With respect to claim 57, we also find no error in the conclusion reached in our original decision that the Examiner reasonably interpreted the broadly set forth claim language as not distinguishing over the Manchester encoded phase shift keying technique used by Carroll in which "zeros" and "ones" are transmitted in different bit portions of a signal. We do agree with Appellants, however, that the Examiner improperly grouped claims 58-60 with claim 57 and pointedly ignored the separate arguments of Appellants with respect to these claims in the Brief. Since there is no evidence of record presented by the Examiner as to what teachings or suggestions in Carroll would support the Examiner's 35 U.S.C. § 103(a) rejection as related to the particular driving signal modulation features of these claims, we are constrained to reverse the Examiner's rejection of claims 58-60.

Appeal No. 2005-0171
Application No. 10/064,380

CONCLUSION

Appellants' request for rehearing is granted to the extent that we have reconsidered our prior decision in light of Appellants' arguments. The Examiner's 35 U.S.C. § 102(e) rejection of claims 36 and 39 and the 35 U.S.C § 103(a) rejection of claims 58-60 are hereby reversed. We are not otherwise persuaded of any errors in our prior decision and maintain the rejections of claims 47, 56, 57, 70, 71, and 75. Thus, the request for rehearing is GRANTED-IN-PART.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective September 13, 2004).

Appeal No. 2005-0171
Application No. 10/064,380

REHEARING/GRANTED-IN-PART


JERRY SMITH

Administrative Patent Judge


LEE E. BARRETT

Administrative Patent Judge


JOSEPH F. RUGGIERO

Administrative Patent Judge

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Appeal No. 2005-0171
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